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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,320	01/14/2002	Peng Huang	45283.5	7761
22828	7590	11/15/2004		
EDWARD YOO C/O BENNETT JONES 1000 ATCO CENTRE 10035 - 105 STREET EDMONTON, ALBERTA, AB T5J3T2 CANADA			EXAMINER TSANG FOSTER, SUSY N	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,320	<b>Applicant(s)</b> HUANG ET AL.	
	<b>Examiner</b> Susy N Tsang-Foster	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the amendment filed on 7/14/2004. The amendment to page 7 of the specification is not compliant because it is on the same page as the abstract. The clean version of the abstract filed on 8/10/2004 is not compliant because the amendment filed on 8/10/2004 neither cancels the previous version of the abstract nor shows the changes made to the abstract compared to the previous version of the abstract. According to the revised amendment practice effective July 30, 2003, (see 68 Fed. Reg. 38611 (June 30, 2003)), each section of an amendment document must be on separate sheets. Amendments to the abstract must be made by presenting a marked up abstract to show the changes made relative to the immediate prior version. An accompanying clean version of the abstract is not required and should not be presented.

2. The declaration under 37 CFR 1.132 filed 7/14/2004 is insufficient to overcome the rejection of claims 1-12 based upon Ghosh et al. (US 6,420,064 B1) as set forth in the last Office action because: The declaration only states that any invention disclosed but not claimed in the '064 Patent was derived from Eric Tang (also known as Zheng Tang) and Debabrata Ghosh, who is also the inventor of the instant application and the '064 Patent. However, the instant applicant contains 3 inventors. The invention disclosed but not claimed in the '064 Patent was invented by Tang and Ghosh which is a different inventive entity from that of the instant application. The inventive entity of the instant application is Tang, Ghosh, and Huang. Therefore, the invention

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disclosed in US 6,420,064 but not claimed is derived from an inventive entity that is different from the inventive entity of the instant application.

Furthermore, there is no statement that the invention disclosed in the '064 patent but not claimed in the '064 patent was not derived from Frank Martel.

Claims 1, and 9 have been amended and claims 25 and 26 are added. Claims 13-24 have been cancelled. Previous art rejections based on Ohara et al., JP '931, and EP 0439938 of record are withdrawn in view of applicant's amendment to claim 1. Claims 1-12 are pending and are finally rejected for reasons of record. New grounds of rejections for newly added claims 25 and 26 are necessitated by applicant's amendment.

#### *Terminal Disclaimer*

3. The terminal disclaimer filed on 7/14/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,420,064 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### *Specification*

4. The abstract of the disclosure is objected to because the phrase "[a]n solid oxide" should be "[a] solid oxide". Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities:

In the Figure 1 caption, "of a anode" should be "of an anode".

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12, 25, and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ghosh et al. (US 6,420,064 B1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

See col. 3, lines 55-67 (especially lines 65-67); col. 4, lines 1-37; col. 5, line 50 to col. 6, line 23; col. 6, lines 63-66; col. 7, line 10-13; col. 7, line 44 to col. 8, line 16 of the reference.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (571) 272-1293. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (571) 272-1292.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

st/ *Susy Tsang-Foster*

Susy Tsang-Foster  
Primary Examiner  
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